

REMARKS

Favorable consideration and allowance of the subject application are respectfully solicited in view of the foregoing amendments and the following remarks.

Finality of the Office Action

Applicants respectfully submit that it was improper to make the April 24, 2003 action final. Under MPEP § 706.07(a), a second action on the merits in any application should not be made final if the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. The Section 102 and Section 103 rejections in the April 24, 2003 Office Action were based on Nakajima et al. (U.S. Patent No. 5,254,525) and Hida et al. (U.S. Patent No. 4,841,134). Nakajima et al. had been made of record but not relied upon in any rejection. Hida et al. is newly cited in the April 24, 2003 Office Action. It is therefore submitted that those rejections constitute a new ground of rejection. Accordingly, the action should not have been made final. Applicants therefore respectfully request that the finality of the April 24, 2003 Office Action be withdrawn.

Request for Consideration of Previously-Submitted Information Disclosure Statements

Applicants filed Information Disclosure Statements on July 10, 2001 and February 20, 2002. Copies of the PTO-1449 Forms included in the IDSs filed have not been returned. Accordingly, Applicants enclose herewith another copy of these PTO-1449 Forms, together with copies of the date-stamped postcard receipts. It is respectfully requested that the

PTO-1449 Forms be initialed and returned indicating that the references listed thereon have been considered.

If the Examiner has any questions regarding the IDSs discussed above or needs copies of any of the references cited therein, the Examiner is urged to contact the Applicants' undersigned attorney at the telephone number listed at the end of this document.

Status of the Claims

Claims 9-21 are pending in this application, with Claims 9, 14, 17 and 18 being independent. Claims 9-13 have been withdrawn from consideration. Claims 15 and 19 are amended herein to delete a term that was objected to by the Examiner. Claims 20 and 21 are newly added. Support for the newly added claims can be found at least at page 10, lines 20-26. No new matter has been added.

Claim Objections

The Examiner has objected to the use of the term "JIS P 8177" in Claims 15 and 19. Without conceding the propriety of this objection, to expedite prosecution, Claims 15 and 19 have been amended to delete the term "JIS P 8177" in accordance with the Examiner's suggestion. Accordingly, withdrawal of the objection is respectfully requested.

Sections 102 and 103 Rejections

Claims 17 and 18 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Nakajima et al. (U.S. Patent No. 5,254,525). Claims 14-16 and 19 were rejected

under 35 U.S.C. § 103(a) as allegedly obvious over Nakajima et al. in view of Hida et al. (U.S. Patent No. 4,841,134). Applicants respectfully disagree with these rejections.

As discussed in the Amendment filed February 5, 2003, the present invention relates to an information recording medium comprising an electronic information storing circuit part, a base material and/or a barrier layer, and an ink receiving layer. The barrier layer is designed to prevent ink applied to the ink receiving layer from coming into contact with the electronic information storing circuit part. Alternatively, the thickness of the ink receiving layer is being made such that ink applied to the ink receiving layer is prevented from reaching the electronic information storing circuit part. In Applicants' view, the cited references do not teach or suggest the claimed invention.

Nakajima et al. relates to a thermal transfer image recording material comprising a support and an image-receiving layer having a transferred image therein. The image on the image-receiving layer is formed by thermal transfer recording using an ink sheet. (See col. 7, lines 13-15.) Nakajima et al. provides that it is preferable to provide IC memories on the support. (See col. 10, lines 54-59.) It also discloses that a cushion layer or barrier layer may be provided between the support and the image-receiving layer to prevent dye diffusion into the support.

In contrast, independent Claim 14 recites an information recording medium comprising an electronic information storing circuit, a base material and an ink receiving layer in this order, and a barrier layer provided between the electronic information storing circuit part and the base material so as to prevent an ink applied to the ink receiving layer from reaching the

electronic information storing circuit part. Applicants submit that Nakajima et al. does not teach or suggest a barrier layer as recited in Claim 14.

Independent Claim 17 recites an information recording medium comprising an electronic information storing circuit, a base material and an ink receiving layer in this order, wherein the ink receiving layer is thick enough to prevent an ink applied to the ink receiving layer from reaching the electronic information storing circuit. As discussed above, while Nakajima et al. provides a cushion layer or barrier layer between the support and the image-receiving layer to prevent dye diffusion into the support, the IC memories described therein is provided on the support. Accordingly, Nakajima et al. does not teach or suggest an ink receiving layer that is thick enough to prevent an ink applied to the ink receiving layer from reaching the electronic information storing circuit.

Independent Claim 18 recites an information recording medium comprising an electronic information storing circuit part and an ink receiving layer in this order, and a barrier layer provided between the electronic information storing circuit part and the ink receiving layer so as to prevent an ink applied with an ink jet head to the ink receiving layer from reaching the electronic information storing circuit part. As discussed above, in Nakajima et al., the image is recorded on an ink-receiving layer with a thermal head. Accordingly, Nakajima et al. does not teach or suggest an ink receiving layer as recited in Claim 18.

Therefore, Nakajima et al. does not anticipate or render obvious the present invention as recited in Claims 17 and 18. Withdrawal of the Section 102(b) rejection is respectfully requested.

Hida et al. relates to an IC card comprising an IC module and a reinforcing sheet. Hida et al. provides that the reinforcing sheet may be a mesh-like sheet for improving mechanical strength and flexibility against bending of card. However, Hida et al. does not teach or suggest an information recording medium comprising a barrier layer having an air permeability of at least 300 sec/100 cc. Furthermore, there is no motivation to combine the references as Hida et al. does not teach or suggest the use of IC card in an information recording medium, let alone dealing with the technical problem that may occur in such an information recording medium: that ink applied to an ink receiving layer adversely influences the IC module.

Accordingly, the information recording medium of the claimed invention is not obvious over Nakajima et al. and Hida et al., either singly or in combination. Withdrawal of the Section 103 rejection is respectfully requested.

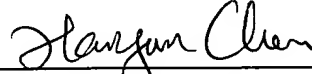
Conclusion

Applicants submit that the present invention is patentably defined by independent Claims 14, 17 and 18. The dependent claims are allowable for the reasons given with respect to their respective independent claims, as well as for the patentable features recited therein. Individual consideration of the dependent claims is respectfully solicited.

Applicants submit that this application is in condition for allowance. Withdrawal of the above-noted rejections, withdrawal of the finality of the Office Action, rejoinder of the withdrawn claims and issuance of a Notice of Allowance are respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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